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Date: January 24, 2007/Jessica Sexton/
Jessica Sexton**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Appellant(s): Cezary Marcjan, *et al.*

Examiner: Raymond J. Bayerl

Serial No: 10/609,104

Art Unit: 2173

Filing Date: June 26, 2003

Title: USER INTERFACE FOR CONTROLLING ACCESS TO COMPUTER OBJECTS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Appellants' representative submits this brief in connection with an appeal of the above-identified patent application. Payment is being submitted via credit card in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP688US].

I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 1-18 stand rejected by the Examiner. Claims 19-22 have been withdrawn. The rejection of claims 1-18 is being appealed.

IV. Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

Claims 10-18 were amended after the Final Office Action dated September 11, 2006. The Examiner has indicated that the amendments will not be entered.

V. Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))**A. Independent Claim 1**

Independent claim 1 recites a computer object access control graphical user interface rendered on a computer display screen for controlling access to a computer object, comprising:
a name field indicating a name for the computer object; and (*See e.g.*, paragraphs [0016] and [0017])

one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object, at least one of the computer spaces is a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users. (*See e.g.*, paragraph [0018])

B. Independent Claim 10

Independent claim 10 recites software executing on a computer system for a computer object access control graphical user interface, comprising

software to render a computer object access control graphical user interface on a computer display screen for controlling access to a computer object, the user interface including a name field indicating a name for the computer object and an access control field indicating plural selectable computer spaces for the computer object, at least one of the computer spaces is a location of a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users. (*See e.g.*, paragraphs [0016-0019])

VI. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37I(1)(vi))

A. Whether claims 10-18 are directed to non-statutory subject matter under 35 U.S.C. §101.

B. Whether claims 1, 2, 5, 7-9 are unpatentable under 35 U.S.C. §103(a) over Cohen-Levy *et al.* (US 5,423,034) in view of Nelson (US 2004/0122849 A1).

C. Whether claims 10, 11, 14 and 16-18 are unpatentable under 35 U.S.C. §103(a) over Cohen-Levy *et al.* (US 5,423,034) in view of Nelson (US 2004/0122849 A1).

D. Whether claims 3, 4, 6, 12, 13 and 15 are unpatentable under 35 U.S.C. §103(a) over Cohen-Levy *et al.* (US 5,423,034) in view of Nelson (US 2004/0122849 A1) and Cohen *et al.* (US 6,507,845 B1).

VII. Argument (37 C.F.R. §41.37(c)(1)(vii))**A. Rejection of Claims 10-18 Under 35 U.S.C. §101**

Claims 10-18 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. The Federal Circuit has clearly established in *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005) and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999) that inventions such as that claimed by appellants are statutory.

This court must also decide whether software code made in the United States and exported abroad is a "component of a patented invention" under 271(f)... Section 271(f) refers to "components of a patented invention."... Title 35, section 101, explains that an invention includes "any new and useful process, machine, manufacture or composition of matter."... Without question, ***software code alone qualifies as an invention eligible for patenting under these categories***, at least as processes. *Eolas Techs., Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). (Emphasis added).

The Federal Circuit in *Eolas Techs., Inc. v. Microsoft Corp.* clearly established that software code alone is statutory subject matter. Independent claim 10 recites a ***computer system***. A computer system by itself is statutory subject matter. By the standards set forth in the above decision, a computer system executing software clearly falls within the categories of statutory subject matter. Moreover, the claim recites a ***graphical user interface*** rendered on a ***computer display screen*** which is also statutory subject matter.

Furthermore, the subject claims produce a useful, concrete, and tangible result.

Because the claimed process [method] applies the Boolean principle to produce a useful, concrete, tangible result ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed.Cir. 1999); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998) (finding a system implementing a financial management structure satisfied §101 because it constituted a practical application of a mathematical algorithm by producing a useful, concrete and tangible result).

As provided above, the legal standard set forth by the Federal Circuit in *A&T Corp. v. Excel Communications, Inc* for determining whether a claim is directed towards statutory subject matter is whether a claim can be applied in a practical application to produce a useful, concrete, and tangible result. The subject claim renders a computer object access control graphical user interface on a computer display screen for controlling access to a computer object which is clearly a useful, concrete and tangible result.

In view of at least the foregoing, it is readily apparent that appellant's invention as recited in independent claim 10 (and associated dependent claims 11-18) is statutory subject matter and produces a useful, concrete, and tangible result. Accordingly, withdrawal of this rejection is respectfully requested.

B. Rejection of Claims 1, 2, 5, 7-9 Under 35 U.S.C. §103(a)

Claims 1, 2, 5, 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen-Levy *et al.* (US 5,423,034) in view of Nelson (US 2004/0122849 A1). Withdrawal of this rejection is requested for at least the following reasons. Cohen-Levy *et al.* or Nelson alone or in combination fail to teach or suggest each and every limitation of appellants' claimed invention.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Appellants' claimed invention relates to a computer object access control graphical user interface for setting computer locations where a computer object can be accessed and users who are permitted to access it. In particular, independent claims 1 recites *a computer object access control graphical user interface rendered on a computer display screen for controlling access to a computer object, comprising a name field indicating a name for the computer object and one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object, at least one of the computer spaces is a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users.*

Cohen-Levy *et al.* and Nelson do not teach or suggest such novel aspects of appellants' claimed invention.

Cohen-Levy *et al.* teaches a file directory structure generator and retrieval tool for use in a computer network. At page 2 of the Final Office Action, the Examiner asserts that the cited document teaches ***one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object***. However, at the cited portions, the reference teaches 'window display 82' that lists in a scrolling window format users recognized by the network, and 'access display window 84' that lists different access rights for the selected user. The cited reference is silent regarding ***one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object*** as recited in the subject claims. The Examiner concedes that Cohen-Levy *et al.* fails to teach access control fields that control access to computer object from computer spaces where at least one of the computer spaces is a computer where one or more users is located during access to the computer object.

The Examiner attempts to compensate for the aforementioned deficiencies of Cohen-Levy with Nelson. Nelson teaches a content management system that provides a user access only to documents within the same domain as the user, or in a public domain. At the cited portions, Nelson teaches a new document being assigned a domain ID as an attribute. This domain ID can be specified by the user who creates the document, or by the system administrator. If no domain ID is specified, the document can be associated with a public domain that is shared by all users of the system. A user has access only to documents that have the same domain ID as the user or are in the public domain. The system processes the database view to limit user's access to items held in the content management database, that are associated with the user domain - each document can have only one domain ID assigned to it. The user cannot select more than one domain that can access the document, so the domain ID does not indicate ***plural selectable*** computer spaces as in appellants' claimed invention. Furthermore, the domain ID does not provide any indication of the computer that the user is employing to attempt access to the document. The domain ID is assigned to the user and not the equipment the user is employing. As a result, the user can access the document from any computer as long as the user's domain ID matches the domain ID of the document. Thus, the system taught by Nelson is silent regarding ***one or more access control fields rendered together and indicating plural***

selectable computer spaces for the computer object, let alone *at least one of the computer spaces is a computer where one or more users is located during access to the computer object* as recited in the subject claims.

In view of the above, it is readily apparent that Cohen-Levy *et al.* and Nelson do not teach or suggest all recited features of independent claims 1 (and claims 2, 5, 7-9 that depend from). Accordingly, it is respectfully requested that this rejection be reversed.

C. Rejection of Claims 10, 11, 14 and 16-18 Under 35 U.S.C. §103(a)

Claims 10, 11, 14 and 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen-Levy *et al.* (US 5,423,034) in view of Nelson (US 2004/0122849 A1). Withdrawal of this rejection is requested for at least the following reasons. Cohen-Levy *et al.* or Nelson alone or in combination fail to teach or suggest each and every limitation of appellant's claimed invention.

Independent claim 10 recites *the user interface including a name field indicating a name for the computer object and an access control field indicating plural selectable computer spaces for the computer object*, *at least one of the computer spaces is a location of a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users*. As discussed above with respect to independent claim 1, Cohen-Levy *et al.* and Nelson do not teach or suggest *an access control field indicating plural selectable computer spaces for the computer object*.

For that reason, it is readily apparent that Cohen-Levy *et al.* and Nelson do not teach or suggest all recited features of independent claim 10 (and claims 11, 14 and 16-18 that depend from). Therefore, it is respectfully requested that this rejection be reversed.

D. Rejection of Claims 3, 4, 6, 12, 13 and 15 Under 35 U.S.C. §103(a)

Claims 3, 4, 6, 12, 13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Cohen-Levy *et al.* in view of Nelson and Cohen *et al.* (US 6,507,845 B1). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Cohen-Levy *et al.*, Nelson and Cohen *et al.* alone or in combination fail to teach or suggest each and every limitation of appellants' claimed invention.

The subject claims respectively depend from independent claims 1 and 10. As discussed *supra*, Cohen-Levy *et al.* and Nelson alone or in combination do not teach or suggest each and every aspect of the subject invention as recited in these independent claims. Moreover, Cohen *et al.* fails to make up for the aforementioned deficiencies of the primary references. Cohen, *et al.* teaches a system for managing collaboration amongst a group of users involved in a task. As conceded in the Office Action dated August 22, 2005, Cohen *et al.* fails to teach or suggest controlling access to the computer object from a computer location. Therefore, it is respectfully submitted that neither Cohen-Levy *et al.*, Nelson nor Cohen *et al.*, alone or in combination teach or suggest appellants' invention as recited in independent claims 1 and 10 (and claims 3, 4, 6, 12, 13 and 15 that depend from). Thus, reversal of this rejection is respectfully requested.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP688US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact appellants' undersigned representative at the telephone number below.

Respectfully submitted,

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VIII. Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1. A computer object access control graphical user interface rendered on a computer display screen for controlling access to a computer object, comprising:
a name field indicating a name for the computer object; and
one or more access control fields rendered together and indicating plural selectable computer spaces for the computer object, at least one of the computer spaces is a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users.
2. The user interface of claim 1 in which the at least one of the computer spaces corresponding to access to the object for one or more computer users is provided by one of plural computer communication formats.
3. The user interface of claim 2 in which the plural computer communication formats include email.
4. The user interface of claim 2 in which the plural computer communication formats include instant messaging.
5. The user interface of claim 1 in which the plural selectable computer spaces for the computer object are listed in a ranked sequence.
6. The user interface of claim 5 in which the sequence is ranked according to associations to the computer object determined automatically from user computer interactions.
7. The user interface of claim 1 in which computer spaces corresponding to a computer and computer spaces corresponding to access for computer users are listed together in a single access control field.

8. The user interface of claim 1 in which computer spaces corresponding to a computer and computer spaces corresponding to access for computer users are listed in separate respective access control fields.
9. The user interface of claim 1 in which access control field includes a flat representation without hierarchy of plural selectable computer spaces corresponding to computer locations of a hierarchical file structure.
10. Software executing on a computer system for a computer object access control graphical user interface, comprising
software to render a computer object access control graphical user interface on a computer display screen for controlling access to a computer object, the user interface including a name field indicating a name for the computer object and an access control field indicating plural selectable computer spaces for the computer object, at least one of the computer spaces is a location of a computer where one or more users is located during access to the computer object and at least one of the computer spaces corresponding to access to the computer object for the one or more computer users.
11. The software of claim 10 in which the at least one of the computer spaces corresponding to access to the object for one or more computer users is provided by a computer communication format.
12. The software of claim 11 in which the computer communication format includes email.
13. The software of claim 11 in which the computer communication format includes instant messaging.
14. The software of claim 10 in which the plural selectable computer spaces for the computer object are listed in a ranked sequence.

15. The software-of claim 14 in which the sequence is ranked according to associations to the computer object determined automatically from user computer interactions.

16. The software-of claim 10 in which computer spaces corresponding to a computer location and computer spaces corresponding to access for computer users are listed together in a single access control field.

17. The software of claim 10 in which computer spaces corresponding to a computer location and computer spaces corresponding to access for computer users are listed in separate respective access control fields.

18. The software of claim 10 in which access control field includes a flat representation without hierarchy of plural selectable computer spaces corresponding to computer locations of a hierarchical file structure.

19-22. (Withdrawn)

IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.